



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,355	09/13/2004	Erica Tsai	60154.301803	5354

32112 7590 04/21/2005

INTELLECTUAL PROPERTY LAW OFFICE
1901 S. BASCOM AVENUE, SUITE 660
CAMPBELL, CA 95008

EXAMINER

WALSH, DANIEL I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/711,355	Applicant(s) TSAI ET AL.	
	Examiner Daniel I. Walsh	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of the response of 3 February 2005. The Examiner maintains his rejection of pending claims 1-15.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5 and 8-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,561,420.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is a broader recitation of the '420 patent, and the differences are well known and obvious in the art, and do not patentably distinguish the present claimed invention.

For instance in claim 1 of the present claimed invention and claim 1 of the '420 Patent, the Applicants claim:

i) "A system for distributing data... front surface...back surface...four edges...one stripe

zone...ring zone...magnetically recorded instances of data...read mechanism.” (see claim 1), whereas in the ‘420 Patent, the Applicants claim “A system for distributing data... front surface...back surface...four edges...one stripe zone...ring zone...magnetically recorded instances of data...read mechanisms.” (see claim 1).

Though the current claimed invention differs from the ‘420 Patent in that it calls for a stationary read mechanism, the Examiner notes that such modification is well known and obvious in the art, (stationary readers) and that such modification does not patentably distinguish the present claimed invention.

For instance in claim 2 of the present claimed invention and claim 2 of the ‘420 Patent, the Applicants claim:

ii) “...contain the data...identifiers associated with at least some of the data...initiates an action automatically...data identifiers.” (see claim 2), whereas in the ‘420 Patent, the Applicants claim “...contain the data...identifiers associated with at least some of the data...initiates an action automatically...data identifiers.” (see claim 2).

For instance in claim 3 of the present claimed invention and claim 3 of the ‘420 Patent, the Applicants claim:

iii) “...database of records...identified fields...when said data identifiers...match said uniquely identified fields.” (see claim 3), whereas in the ‘420 Patent, the Applicants claim “...database of records...identified fields...when said data identifiers...match said uniquely identified fields.” (see claim 3).

For instance in claim 4 of the present claimed invention and claim 4 of the '420 Patent, the Applicants claim:

iv) "...telephone device...dialing said telephone number." (see claim 4), whereas in the '420 Patent, the Applicants claim "...telephone device...dialing said telephone number." (see claim 4).

For instance in claim 5 of the present claimed invention and claim 5 of the '420 Patent, the Applicants claim:

v) "... (GPS) device...displaying a map or route based on the GPS data..." (see claim 5), whereas in the '420 Patent, the Applicants claim "... (GPS) device...displaying a map or route based on the GPS data..." (see claim 5).

Re claims 8 and 15, though the '420 Patent is silent to plastic or paper as a substrate material, the Examiner notes that it is well known and conventional that card are made of plastic/paper. As such limitations are so well known and conventional, they do not distinguish the present claimed invention from the prior art of record.

For instance in claim 9 of the present claimed invention and claim 6 of the '420 Patent, the Applicants claim:

vi) "...front surface, a back surface...visually recognizable indicia...stripe zone...ring zone...read mechanism." (see claim 9), whereas in the '420 Patent, the Applicants claim

“...front surface, a back surface...visually recognizable indicia...stripe zone...ring zone...read mechanism.” (see claim 6).

Though the current claimed invention differs from the ‘420 Patent in that it calls for a stationary read mechanism, the Examiner notes that such modification is well known and obvious in the art, (stationary readers) and that such modification does not patentably distinguish the present claimed invention.

For instance in claim 10 of the present claimed invention and claim 7 of the ‘420 Patent, the Applicants claim:

vii) “...zones does contain the data.” (see claim 10), whereas in the ‘420 Patent, the Applicants claim “...zones does contain the data.”

For instance in claim 11 of the present claimed invention and claim 8 of the ‘420 Patent, the Applicants claim:

viii) “...data includes at least one encoded version of at least some of the visually recognizable indicia...” (see claim 11), whereas in the ‘420 Patent, the Applicants claim “...data includes at least one encoded version of at least some of the visually recognizable indicia...” (see claim 8)

For instance in claim 12 of the present claimed invention and claim 9 of the ‘420 Patent, the Applicants claim:

“...data identifiers associated with at least some of the data.” (see claim 12), whereas in the ‘420 Patent, the Applicants claim “...data identifiers associated with at least some of the data.” (see claim 9)

3. Claims 6 and 13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,561,420 in view of U.S. Patent No. 5,942,744.

Though the ‘420 Patent is silent to a data orientator, the Examiner notes that such orientations are well known and conventional in barcodes, magnetic stripes, and ring zones. Such orientators can take the form of a recognizable string of data indicating an orientation, or can take the form of a physical mark detected to determine orientation. Specifically, the ‘744 Patent teaches (col 39, lines 58+) data orientators to permit a card to be inserted and read regardless of orientation. Accordingly, it would have been obvious to one of ordinary skill in the art to combine the teachings, in order to permit reading of a card regardless of orientation.

4. Claims 7 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent No. 6,561,420 in view of U.S. 2003/0205615. Though the ‘420 Patent is silent to extensible markup language tagging, the ‘615 art teaches such tagging/language (abstract, for example) so that data can be processed easily with most available software. Therefore, it would have been obvious to one of ordinary skill in the art to combine the teachings to make the card more convenient for use.

Response to Arguments

5. Re the applicants arguments (claims 1, 9, and their depending claims) that moving a card and holding one stationary are clearly different principles of operation, the Examiner agrees moving a card is different than holding one stationary when being read. However, the Examiner notes that the structure of a magnetic card (stripe) lends itself to being used in different modes, namely those where the card is moved and those where the card is stationary. For a magnetic card to be read by moving the card or holding the card stationary, there is no requirement for reconstruction, redesign, etc. of the card. Both card readers (stationary read mechanism and those where the card is moved) are functionally equivalent in as much as they are both able to read magnetic cards. Both are well know and conventional in the art, and obvious expedients for card reading (see Foote US 4,041,279 col 1, lines 9+ which teaches readers where the card moves and the reader is stationary and vice versa).

6. Re the Applicants argument (claims 6 and 13) that the '744 Patent does not teach a stationary read mechanism, the Examiner notes that indeed claim 6 depends on claim 1. However, claim recites a system with magnetic stripe and zones, and a stationary reader to read the data in at least of the zones. Claims 6 and 13 (and their parent claims 1 and 10) therefore do not require that the ring zone be read by a stationary read mechanism, and thus, reading of a ring zone by a non-stationary read mechanism, when the stripe can be read by a stationary read mechanism, is therefore permissible.

7. Re the Applicants argument (claims 7 and 14), though the present application is a CIP of application US Application 10371928 which is a divisional of US Application 09835961, the

Examiner notes that as the teachings of extensible markup language were not disclosed in the related applications, the priority date for the present application is interpreted as the filing date. Accordingly, the Examiner maintains his rejection regarding claims 7 and 14, noting that xml data on a card has been taught as being desirable for providing data (format) that can be easily processed.

Additional Remarks

8. The Examiner also notes that US 2004/0076105 appears to teach at limitations of the independent claims (see FIG. 10A for example). The Examiner suggests the Applicant consider the reference prior to their reply, in addition to the related applications/patents of the '105 Application (the series of Patents/Applications to Dcard). The Examiner notes that at least the '105 Application appears to teach a card with a magnetic stripe and a magnetic ring zone on the same side that can be read by standard card readers.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Rogers et al. (US 3,686,479), Rogers (US 3,717,749), Sonier (US 3,959,627), Schasser (US 4,088,878), Moss et al. (US 4,197,988), Schasser (US 4,213,039), Casden (US 4,585,930), King et al. (US 2004/0076105), and Foote (US 4,041,279).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to **[daniel.walsh@uspto.gov]**.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set for the in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 10/711,355
Art Unit: 2876

Page 10
D. Walsh

A handwritten signature in black ink, appearing to be 'D. Walsh', written in a cursive style.

DW
4/15/05

A handwritten signature in black ink, appearing to be 'Karl D. Frech', written in a cursive style.

KARL D. FRECH
PRIMARY EXAMINER